

Application No. 10/658,578  
Reply to Office Action of April 20, 2007

**REMARKS / ARGUMENTS**

The present application includes pending claims 1-28, all of which have been rejected. By this Amendment, claims 2-18 have been amended, as set forth above, to further clarify the language used in these claims and to further prosecution of the present application. The Applicant respectfully submits that the claims define patentable subject matter.

**Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.**

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial* review of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-28 stand rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. The Applicant

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respectfully traverses these rejections at least based on the following remarks.

### **REJECTION UNDER 35 U.S.C. § 101**

The Applicant turns to the rejection of claims 1-28 under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

The Office Action states the following:

Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 19 recite a method and a system, respectively. These claims appear to include a judicial exception, namely, a data manipulation or abstract idea. Note that the method steps recited in claim 1 and the elements recited in claims 19 are disclosed by specification and claims 10 as computer instructions. Since there are no practical applications claimed, i.e., no physical transformation taken place, nor a useful, concrete and tangible result being produced, the claims are non-statutory.

See the Office Action at page 2. The Applicant respectfully submits that the rejection under 35 USC §101 is improper since the applicant's claimed invention produces a useful, tangible and concrete result, and has practical application.

#### **I. Telephone Conference with the Supervisory Patent Examiner**

The Applicant points out that on July 17, 2007, a telephone conference was conducted between the undersigned Attorney for Applicant ("Attorney") and Supervisory Patent Examiner ("SPE") Chi Pham. The Attorney and SPE Pham discussed the present rejection under 35 USC § 101. The Attorney pointed out

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that the rejection of claims 1-28 under 35 USC § 101 is erroneous since Applicant's claims produce useful, tangible and concrete result. **After briefly reviewing the Office Action and Applicant's claims, SPE Pham agreed with the Attorney that the rejection of at least claims 1-9 and 19-28 under 35 USC § 101 is erroneous.** Furthermore, SPE Pham advised that the rejection of claims 10-18 under 35 USC § 101 will be withdrawn if claims 10-18 are amended so that the limitation "machine-readable storage" is replaced with "computer-readable medium". The Applicant has amended claims 10-18 to comply with SPE Pham's request.

At least for the above reasons, the Applicant submits that the rejection of claims 1-28 under 35 USC § 101 should be withdrawn.

**II. Regarding the Applicant's Claims 1-28, the Examiner Has Failed to Establish a Prima Facie Case of Unpatentability**

The Applicant respectfully asserts that the Examiner has not established a prima facie case of unpatentability since the Examiner has not identified and explained "**the basis for why a claim is for an abstract idea with no practical application.**" Accordingly, the burden has not shifted to the Applicant to either amend the claim or make a showing of why the claim is eligible for patent protection. See, In re Brana, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995). See also, generally, MPEP § 2107.

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**A. The Applicant's Invention Produces Useful, Tangible And Concrete Results**

The Applicant respectfully asserts that the disclosed and claimed invention produces useful, tangible and concrete results. The Applicant's invention provides utility that is (i) specific, (ii) substantial and (iii) credible. See MPEP § 2107 and Fisher, 421 F.3d, 76 USPQ2d at 1230. **For example, each of claims 1-28 provides a practical application that produces a useful result, i.e., a method for bandwidth management and bandwidth sharing in a hybrid wired/wireless local area network.** Furthermore, the Applicant's disclosed and claimed invention clearly does not fall in the category of the § 101 Judicial exceptions. Accordingly, there is no need for the Applicant to distinguish the disclosed and/or claimed subject matter from the three § 101 judicial exceptions to patentable subject matter by specifically reciting in the claim the practical application.

With regard to tangible results, the Applicant respectfully asserts that the disclosed and claimed invention recites more than a § 101 judicial exception and that the claims specifically set forth a practical application to produce a real-world result.

With regard to concrete results, since appropriate rejection under 35 U.S.C. § 101 should be accompanied by a lack of enablement rejection under 35 U.S.C. § 112, paragraph 1, in instances where the invention cannot operate as intended without undue experimentation. Since no such rejection was received, the

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Applicant assumes that the invention provides useful results. Notwithstanding, the Applicant respectfully asserts that the disclosed and claimed invention provides useful results and the results are repeatable and predictable.

The Applicant points out that the preambles of independent claims 1, 10 and 19 specifically recite the utility of Applicant's claims, i.e., for bandwidth management and bandwidth sharing in a hybrid wired/wireless local area network. Furthermore, in accordance with Examiner's recommendation stated in page 3 of the Office Action, the Applicant has amended claims 10-18 so that the limitation "machine-readable storage" is replaced with "computer-readable medium." At least for the above reasons, the Applicant believes that Claims 1-28 comprise patentable subject matter and are believed to be allowable.

The Examiner has stated that claims 1, 10 and 19 have "no practical application". The Applicant respectfully disagrees. For example, claim 1 recites that bandwidth may be initially reserved for an access device, access point and/or a switch; and the reserved bandwidth may then be allocated in response to a communication session associated with the access device, access point and/or the switch, which is a useful, concrete and tangible result. Furthermore, the Examiner is referred to at least paragraphs 36-65, for example, of the Specification for additional clarification with regard to the bandwidth management and sharing in a hybrid wired/wireless LAN.

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Accordingly, the Applicant courteously requests that the rejection under 35 USC § 101 be withdrawn and each of Claims 1-28 be allowed. The Applicant reserves the right to argue additional reasons beyond those set forth above that support the allowability of all rejected claims.

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**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-28 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,



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